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Atty Docket No. 020366-043100US

PTO FAX NO.: 1-571-273-8300

ATTENTION: Examiner Cong Lac T. Huynh

Group Art Unit 2178

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF  
EXAMINER Cong Lac T. Huynh**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following documents in re Application of Russ L. Albert et al., Application No. 09/001,643, filed December 31, 1997 for INTERNET-BASED DATABASE REPORT WRITER AND CUSTOMER DATA MANAGEMENT SYSTEM are being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Documents Attached

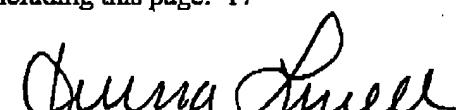
1. Transmittal Form (1 page);
2. Fee Transmittal (1 page +copy); and
3. Appeal Brief Under 37 CFR §41.37 (15 pages).

Number of pages being transmitted, including this page: 17

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Dated: October 26, 2005

  
Aurora Lowell, Assistant to

Irvin E. Branch, Reg. No. 42,358

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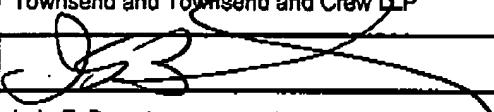
PAGE 1/18 \* RCVD AT 10/26/2005 5:30:26 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-6/29 \* DNIS:2738300 \* CSID: \* DURATION (mm:ss):04:18

PTO/SB/21 (09-04)

<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/001,643
		Filing Date	December 31, 1997
		First Named Inventor	Albert, Russ L.
		Art Unit	2178
		Examiner Name	Cong Lac T. Huynh
		Total Number of Pages in This Submission	16
	Attorney Docket Number	020366-043100US	

ENCLOSURES (Check all that apply)				
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC		
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences		
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)		
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information		
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter		
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):		
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<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD			
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53				
<table border="1"> <tr> <td>Remarks</td> <td>The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.</td> </tr> </table>			Remarks	The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.
Remarks	The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.			

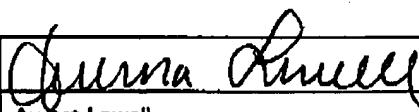
**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Irvin E. Branch		
Date	October 26, 2005	Reg. No.	42,358

**CERTIFICATE OF TRANSMISSION/MAILING**

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Aurora Lowell

Date

October 26, 2005

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<b>Effective on 12/08/2004.</b> <b>Fees pursuant to the Consolidated Appropriations Act, 2006 (H.R. 4818).</b>		<b>RECEIVED</b>	
<b>FEE TRANSMITTAL</b> <b>For FY 2005</b>		<b>CENTRAL FAX CENTER</b>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		<b>OCT 26 2005</b>	
<b>TOTAL AMOUNT OF PAYMENT</b>	<b>(S) 500</b>	Attorney Docket No. 020366-043100US	

**METHOD OF PAYMENT** (check all that apply)

Check  Credit Card  Money Order  None  Other (please identify): \_\_\_\_\_  
 Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP

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 under 37 CFR 1.16 and 1.17

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Fee Paid (\$)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent

Small Entity	
Fee (\$)	Fee (\$)
50	25

Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent

200	100
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Multiple dependent claims

360	180
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Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
-20 or HP =	x	=				

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Fee (\$)	Fee Paid (\$)
-3 or HP =	x	=			

HP = highest number of independent claims paid for, if greater than 3

**3. APPLICATION SIZE FEE**

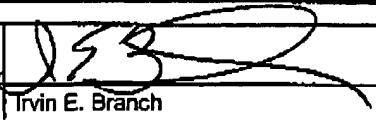
If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: Filing a brief in support of an appeal 500

SUBMITTED BY	
Signature	
Name (Print/Type)	Irvin E. Branch
Registration No. (Attorney/Agent)	42,358
Telephone	303-571-4000
Date	October 26, 2005

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Attorney Docket No.: 020366-043100US

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By: Aurora Russell  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Russ L. Albert et al.

Application No.: 09/001,643

Filed: December 31, 1997

For: INTERNET-BASED DATABASE REPORT  
WRITER AND CUSTOMER DATA  
MANAGEMENT SYSTEM

Customer No.: 20350

Confirmation No. 6919

Examiner: Cong Lac T. Huynh

Technology Center/Art Unit: 2178

APPEAL  
BRIEF UNDER  
37 CFR §41.37

**MAIL STOP: APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellants offer this Brief further to the Notice of Appeal mailed on August 26, 2005.

**1. Real Parties in Interest**

Qwest Communications International Inc. is the real party in interest of the above-identified application.

**2. Related Appeals and Interferences**

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

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### 3. Status of Claims

Claims 1 - 12 are currently pending in the application, but stand rejected by the Examiner. All of these claims stand rejected pursuant to the Final Office Action mailed April 28, 2005 ("Office Action"). The rejections of each of Claims 1 - 12 is believed to be improper and are the subject of this appeal.

### 4. Status of Amendments

No amendments have been filed subsequent to the Office Action.

### 5. Summary of Claimed Subject Matter

Embodiments of the invention relate to systems and methods for processing customer billing and inventory information which may allow customer access to such information via an Internet based connection (Application, p. 1, ll. 4 - 8). The dramatic growth of the Internet has created greater opportunities for providers of services to introduce new services for customers which are tailored to take advantage of the increased speed and efficiency of communicating using the Internet (*id.*, p. 1, ll. 10 - 13). One such area involves processing of customer account data relating to services rendered and generating associated billing reports for each customer (*id.*, p. 1, ll. 15 - 18). Of particular concern to the invention is providing access to customer account data to users both in and outside a provider of services (*id.*, p. 1, ll. 18 - 21).

Traditionally, processing and billing arrangements relied on traditional mailing of hardcopy bills to customer premises and possibly automated telephone systems and the associated support staff to allow users to access billing and inventory data (*id.*, p. 1, ll. 22 - 26). The invention takes advantage of the efficiency and convenience offered by the Internet and graphical user interfaces to overcome the restrictions of these traditional methods (*id.*, p. 1, ll. 26 - 27 & p. 2, ll. 1 - 2). In doing so, the invention allows for drilling down to specific information within data, easier entry of consumer data and comprehensive database access and management, capabilities not offered in the prior arrangements (*id.*, p. 2, ll. 6 - 9).

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Embodiments of the invention allow a user to create reports combining customer billing and inventory data from provider of services with data the customer provides and maintains (*id.*, p. 11, ll. 14 – 16). For example, a customer could maintain a database of cost accounting codes which are assigned to particular telephone numbers to track telephony expenses (*id.*, p. 11, ll. 16 – 19). The customer could thereafter create a report using the invention that displays billing data from a provider of services along with data separately maintained by the consumer, making the report more valuable to the customer (*id.*, p. 11, ll. 19 – 28).

a. Independent Claim 1

Independent Claim 1 recites a system for generating an on-line report, which includes a number of aspects of the invention as described above. The system comprises a host site (*id.*, Fig. 1, 14) connected to a user terminal (*id.*, Fig. 1, 12) via an internet connection (*id.*, Fig. 1, 16). The host site includes a processor terminal (*id.*, Fig. 1, 20) which receives user report requests and sends reports to users (*id.*, p. 5, ll. 9 - 11). The processor terminal comprises a view manager (*id.*, Fig. 2, 106) which allows a user to create reports from information stored in a database (*id.*, p. 7, ll. 1 - 5). The processor terminal also comprises a data manager (*id.*, Fig. 2, 104) which allows a user to relate customer billing and inventory data with data the customer provides and maintains (*id.*, p. 11, ll. 14 - 16). The data provided and maintained by the customer is maintained independently from the host computer site (*id.*).

b. Independent Claim 8

Independent Claim 8 recites a method for generating an on-line report, which includes a number of aspects of the invention as described above. The method comprises providing a graphical display of views a user can work with along with a set of function commands which can be used to manage the views (*id.*, p. 5, ll. 26 - 29). A view is a definition of a type of report (*id.*, p. 5, ll. 29 - 31). A report displays data stored at a host site as well as

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data maintained independently from the host site (*id.*, p. 11, ll. 14 - 16). The method also comprises creating a report based upon creating a report using said definition (*id.*, p. 6, ll. 24 - 25). The method also comprises displaying the report to the user (*id.*, p. 6, ll. 21 - 23).

#### 6. Ground of Rejection Presented for Review

##### a. Claims 1 - 4 and 6 - 11

Claims 1 - 4 and 6 - 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anand et al. (US Pat. No. 5,710,900; "Anand") in view of Jagadish et al. (US Pat. No. 6,058,170; "Jagadish").

##### b. Claims 5 and 12

Claims 5 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anand in view of Jagadish, and further in view of Melchione et al. (US Pat. No. 5,930,764; "Melchione").

#### 7. Argument

##### a. Whether Claims 1 - 4 and 6 - 11 are patentable over Anand in view of Jagadish

The Office Action has rejected Claims 1 - 4 and 6 - 11 under 35 U.S.C. §103(a) as being unpatentable over Anand in view of Jagadish. For a rejection to be maintained under 35 U.S.C. §103(a), the Examiner is charged with putting forth a *prima facie* showing of obviousness. Appellants believe a *prima facie* case has not been properly set forth by the Examiner with respect to the rejection of these claims.

The basic test for obviousness is excerpted below:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

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reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

The primary reference, Anand, describes a system for generating reports from a computer database (Anand, Col. 1, ll. 4 – 7). The system provides a graphical user interface ("GUI") which allows a user to create reports from data stored on the computer database (*id.*, Col. 2, ll. 1 – 4). The GUI resides on a client subsystem (*id.*, Col. 5, ll. 24 – 27). The computer database may be a collection of data that is housed in one or more databases such as those in a data warehouse (*id.*, Col. 4, ll. 1 – 2). There is no indication that the system may create reports displaying data maintained independently from the computer database.

The Office Action acknowledges that "Anand does not disclose relating data maintained independently from the host site ... as part of a requested report, wherein at least a portion of the data maintained independently from the host computer site ... is displayed as part of the requested report" (Office Action, p. 3), and instead relies on Jagadish for this limitation. Jagadish describes a system for generating telephone bills from a database (Jagadish, Col. 1, ll. 37 - 39) that include summary information based on customer defined parameters (*id.*, Col. 3, ll. 59 - 66).

Notwithstanding the assertion in the Office Action, Jagadish also fails to teach the limitation of relating data maintained independently from the host site as part of a requested report. Jagadish discloses a system involving customer defined parameters, raw data, and summary information (*id.*, Col. 3, ll. 39 - 48). Parameters are customer defined information which is applied to raw data to produce summary information (*id.*). Parameters, therefore, are used to create summary information, which may be displayed, possibly along with raw data, but are themselves not described as being displayed in Jagadish.

It becomes apparent then that Jagadish describes independently stored parameters that are used to manipulate data stored on a host site (*id.*, Col. 1, ll. 39 - 48). For example,

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Jagadish describes using independently stored pricing data to determine and display the cost of a phone call stored in a separate database (*id.*). Jagadish, however, does not disclose relating in a report both the outcome of this manipulation and the underlying parameter used in the manipulation. Per the example above, the system in Jagadish only discloses reporting the calculated cost of the phone call, but not the underlying independently stored pricing data. Therefore, Jagadish does not disclose “relating data maintained independently from the host site ... as part of a requested report, wherein at least a portion of the data maintained independently from the host computer site ... is displayed as part of the requested report[,]” as is present in Claims 1 and 8 (emphasis added).

Additionally, there would also be no reasonable expectation of success in combining the references of Anand and Jagadish to produce a system that displays both independently maintained data and data from a host computer site. Combining Anand and Jagadish would produce a system that could display data from a host system and the results of calculations involving such data with independently maintained data, but not display the independently maintained data as the Appellants’ claimed invention does.

Finally, the Office Action does not state a cognizable suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the two references. The Office Action merely states that it would have been obvious to one skilled in the art to combine the references because an advantage would be realized. The test for motivation-to-combine requires not only that a motivation exist, but that a motivation to combine exist (“[t]he mere fact that references can be combined ... does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” MPEP §2143). Neither Anand or Jagadish discloses that some advantage could be achieved, or problem solved, if only a system could display independently maintained data with host system data.

A *prima facie* case of obviousness has not been properly set forth in the Office Action because (1) not all the limitations of Claims 1 and 8 are taught or suggested by the prior art; (2) there would be no reasonable expectation of success in combining the references to achieve

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what the claimed invention achieves; and (3) there is no motivation to combine the prior art. Claims 1 and 8 are, therefore, believed to be allowable. Claims 2 – 4 and 6 – 11 depend from Claims 1 or 8 and are therefore believed to be allowable at least by virtue of their dependence from allowable claims.

b. Whether Claims 5 and 12 are patentable over Anand in view of Jagadish and further in view of Melchione

The Office Action has rejected Claims 5 and 12 under 35 U.S.C. §103(a) as being unpatentable over Anand in view of Jagadish and further in view of Melchione. Claims 5 and 12 depend from Claims 1 or 8 and are therefore believed to be allowable by virtue of their dependence from allowable claims. Additionally, for a rejection to be maintained under 25 U.S.C. §103(a), the Examiner is charged with putting forth a *prima facie* showing of obviousness. Appellants believe a *prima facie* case has not been properly set forth by the Examiner with respect to the rejection of these claims.

The basic test for obviousness is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.” MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Claim 5 depends from Claim 1 and the examiner states that Claim 12 is the method performed by the system of Claim 5. Therefore, the Office Action proposes that combining Melchione into the previously improperly combined Anand and Jagadish renders Claims 5 and 12 obvious. The Office Action states that combining the threshold criteria

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searching of Melchione with the other two references provides the advantage of quickly selecting needed data from a database.

The Office Action, however, does not state a cognizable suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the three references. The Office Action merely states that it would have been obvious to one skilled in the art to combine the references because an advantage would be realized. The test for motivation-to-combine requires that not only a motivation exist, but that a motivation to combine exist (“[t]he mere fact that references can be combined ... does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” MPEP §2143). Neither Anand, Jagadish nor Melchione disclose that some advantage could be achieved, or problem solved, if only a system could apply threshold criteria searching to a database when generating reports including both independently maintained data and host system data.

A *prima facie* case of obviousness has not been properly set forth in the Office Action because there is no motivation to combine the prior art. Additionally, Claims 5 and 12 depend from Claims 1 and 8 and are therefore also believed to be allowable by virtue of their dependence from allowable claims.

#### 8. Claims Appendix

Appendix A is submitted herewith containing the claims involved in the appeal.

#### 9. Conclusion

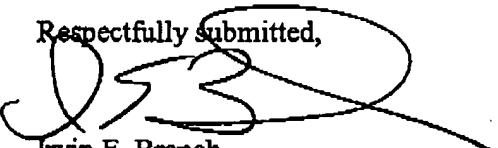
Thirteen office actions and three advisory actions have been issued on the present case. For all the forgoing reasons, Appellant's respectfully request that the rejection be judiciously and expediently withdrawn and the claims be allowed.

Please deduct the requisite fee of \$500.00 pursuant to 37 C.F.R. §41.20(b)(2) from debit deposit account 20-1430 and any additional fees that may be due in association with the filing of this Appeal Brief.

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If for any reason the Office believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Office is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,  
  
Irvin E. Branch  
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
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APPENDIX A

*The claims pending in the application are as follows:*

1. (Previously Presented) A system for generating an on-line report containing user billing and inventory information comprising:

a host site connected to at least one user computer terminal via an on-line interconnection, said host site comprising a database for storing the user billing and inventory information, and a processor terminal connected to the on-line interconnection for receiving user report requests and sending reports created in response to the received requests and additional on-line user input, wherein said processor terminal comprises:

a view manager arranged to generate a set of function commands which can be selectively launched by user input to graphically display a list of available views each of which contains a report relating to particular user information stored in a database, create a new view and report, and edit a view and report; and

a data manager arranged to relate data maintained independently from the host site on a user computer terminal with the user's billing and inventory data for display as part of a requested report, wherein at least a portion of the data maintained independently from the host computer site is displayed as part of the requested report.

2. (Original) The system of claim 1 wherein said view manager comprises a view editor arranged to receive and implement user report editing instructions.

3. (Original) The system of claim 2 wherein said view editor comprises a plurality of editing commands which are graphically displayed in the graphical user interface.

4. (Original) The system of claim 3 wherein said plurality of editing commands comprise a drill down command, a grouping command, a sort command, and a total amount command.

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5. (Original) The system of claim 1 wherein the view manager further comprises a report filter arranged to receive user defined filter values for use as threshold values to selectively control which database information will be included in a report.
6. (Original) The system of claim 1 wherein the on-line interconnection comprises an Internet connection and web browser.
7. (Original) The system of claim 1 wherein the graphical user interface comprises JAVA applets and an HTML page.
8. (Previously Presented) A method for generating an on-line report containing user billing and inventory information in response to an inquiry from a user computer terminal via an on-line connection, said method comprising:

generating a graphical user interface for on-line access by the user, said graphical user interface providing a set of function commands which can be selectively launched to graphically display a list of available views each of which contains a report relating to particular user information stored in a host site database, create a new view and report, edit a view and report, and relate data maintained independently from the host site on the user computer terminal with the user's billing and inventory data for display in a report;

creating a report based on user responses to the set of commands;

including at least a portion of the data maintained independently from the host computer site in the report; and

sending the created report to the user terminal via the on-line connection.

9. (Original) The method of claim 8 further comprising providing report editing commands which can be accessed through the graphical user interface to specify desired data to be produced in a report.

10. (Original) The method of claim 9 further comprising providing report editing commands which can be accessed through the graphical user interface to specify a desired report format.

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11. (Original) The method of claim 9 further comprising providing report editing commands which allow on-line user control of display, sorting, accounting, and grouping of report content.
12. (Original) The method of claim 9 further comprising providing report editing commands which allow a user to input content filtering constraints to limit the quantity of user information produced in a report.

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**EVIDENCE APPENDIX**

Not included.

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**RELATED PROCEEDINGS APPENDIX**

Not included.